

REMARKS

Claims 1-49 are pending, with claims 9, 17, 33, 41 and 49 being independent. Claims 1-8 and 25-32 have been withdrawn. Claims 9, 17, 33, 40, 41, 44, and 49 have been amended. Support for the amendments is found, for example, at page 20 of the specification. No new matter has been introduced.

35 U.S.C. § 103(a) and 35 U.S.C. § 102(e) Rejections

Claims 9-16, 19, 20, 23, 24, 33-40, 43, 44, and 47-49 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Blaser (U.S. Patent No. 6,757,661). Applicants submit that Blaser fails to describe or suggest the limitations of the amended independent claims.

For example, amended claim 9 recites, *inter alia*, a computer-implemented method for determining a score of an ad using a host. Using the host and at a local time for the host, local time of interest information associated with a request from a remote computer is received. The local time of interest information from the remote computer varies with the local time of interest information for the host. Using the host, an ad associated with local time of interest price information is accessed, the local time of interest price information indicating a price for an ad in association with a local time for a remote system perceiving the ad. And, using the host, it is determined whether the local time of interest price information for the ad is related to the received local time of interest information for the remote computer. Applicants respectfully submit that Blaser fails to describe or suggest these limitations.

As a preliminary matter, the Office Action indicated that recitation of the intended use must result in structural differences between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. See page 10 (citing to *In re Collier*, 158 USPQ 266, 267 (CCPA 1968)).¹ The Office Action also noted that language appearing in bold in the Final Office Action was not considered for the purpose of narrowing the

¹ "Where the court interpreted the claimed phrase 'a connector member for engaging shield means' and held that the shield means was not a positive element of the claim since '[t]here is no positive inclusion of 'shield means' in what is apparently intended to be a claim to structure consisting of a combination of elements.'"

claims. Applicant submits that the amendments to the independent claims result in structural differences between the amended independent claims and Blaser. For example, claim 9 now recites "receiving, using the host and at a local time for the host, local time of interest information associated with a request from a remote computer, wherein the local time of interest information from the remote computer varies with the local time of interest information for the host," and these elements impose structural differences.

In the rejection of the claims, the Final Office Action seems to argue that the language most closely corresponding to these limitations in the prior instance of claim 9 are inherent in Blaser. For example, in describing a configuration in which the advertisements are scheduled, the Final Office Action notes, "[T]he Examiner understands that if Blaser is obtaining user information including geographic information and the serving of advertisements is controlled by time of day scheduling requirements, Blaser must [be] obtaining local time information of the user. Otherwise, the serving constraint of 'time of day' (e.g. 2:00 pm daily) would be completely negligible, as it would always be 2:00 pm somewhere, regardless of the end user's location, thus resulting in the advertisement always being served." Applicant submits, however that in order for these features to be considered to be inherent, extrinsic evidence makes it clear that the subject matter is necessarily present in (i.e., necessarily flows from) the disclosure of cited art, and that ordinarily skilled artisans would recognize it. See MPEP 2112. Applicant submits that the Office has failed to meet this burden by demonstrating that these features are necessarily present, and applicant further submits that these features are not present in Blaser.

The Office Action seems to recognize that Blaser is deficient in several respects by noting:

Blaser does not explicitly disclose accessing, using the host, an ad associated with local time of interest price information, the local time of interest price information indicating a price for an ad in association with a local time; determining, using the host, whether the local time of interest price information for the ad is related to the received local time of interest information; and if it is determined that the local time of interest price information for the ad is related to the received local time of interest information, then using the host to determine a score for the ad using at least the local time of interest price information.
Emphasis Added.

However, the Office Action states that it would have been obvious "to modify Blaser to include price information in addition to the performance information already disclosed in Blaser. As per the teachings of Blaser, there is a direct correlation between ad performance and advertiser pricing criterion and it is a common practice in the art that advertisers determine pricing criterion and bidding schemes based on performance of the ads." (Final Office Action, page 8). Applicant submits that the approach taken in the rejection is fundamentally flawed and cannot be relied upon because Blaser fails to describe or suggest the detailed limitations required by amended claim 9, and because Blaser also fails even to address the larger problem to which amended claim 9 is directed. That is, Blaser fails to appreciate that there are differences in the local time between a host and a remote computer, and that these differences can cause a variety of complications. Thus, not only does Blaser fail to describe or suggest these limitations, Blaser does not even contemplate the challenges and environment in which amended claim 9 operates. And, without an understanding of these factors, Blaser cannot serve as the basis of a well-reasoned obviousness rejection.

In prior Office Actions, the Office expressed concerns about an environment in which the host and the remote computer are in different time zones. See Office Action dated 6/11/2009.² Applicant submits that the environment contemplated by claim 9 does not require the host and remote computer to be in different time zones for every request that is received. Rather, claim 9 relates to a subset of use cases involving the host and the remote computer where the local time of interest information from the remote computer varies with the local time of interest information for the host. This configuration is in fact supported throughout the specification.

Accordingly, the withdrawal of the rejection of claim 9 and its dependent claims is respectfully requested. Amended independent claims 17, 33, 41, and 49 recite similar limitations and are believed to be allowable for similar reasons. Accordingly, allowance of these amended independent claims and their dependent claims also is respectfully requested.

² Rejecting a claim under 35 U.S.C. 112 and noting "Essentially, the Applicant is now requiring that the client and the host must be in separate local times (i.e. time of day, weekday, season, etc. as detailed in claim 10), which the Examiner notes in some cases is impossible, as is detailed in the 35 U.S.C. 112, 2nd paragraph rejection below. There is no clear support for such a concept in the original disclosure."

Conclusion

It is believed that all of the pending issues have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this reply should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this reply, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Applicant submits that all claims are in condition for allowance.

The \$810 RCE fee is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. No other fees are believed due. Please apply any charges or credits to Deposit Account No. 06-1050, referencing Attorney Docket No.16113-0767001

Respectfully submitted,

4/23/2010
Date: _____

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